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In re Application of :
Robert Bristol et al. : DECISION
Serial No.10/679,816 : ON
Filed: October 06, 2003 : PETITION
For: ENHANCING PHOTORESIST PERFORMANCE USING ELECTRICAL FIELDS

This is a decision on the Petition under 37 CFR 1.181 filed November 07, 2006, requesting the withdrawal of the finality of the Office action dated October 10, 2006 and a new action to be issued addressing the merits of the claimed invention.

Issues:
The applicants provide the following argumentst:1)In the first Office action mailed March 23, 2006, the rejection improperly treated all independent and dependent claims as a group under various 102(b) rejections. The Office Action did not indicate that the Examiner considered the patentability of each claim independently. 2) The Applicants responded on May 30, 2006 . In this response applicant pointed out it was necessary to provide a rejection with respect to the dependent claims and consider the patentability of each claim independently, 3) In the Examiner's final Office Action mailed October 10, 2006, the Examiner still rejected as a group each independent and dependent claim and failed to address each of the dependent claims. The examiner addressed some but not all of the dependent claims and rejected claims without explanation and that the issuance of a final rejection without providing basis for the rejection of the claims prior to final rejection is improper. The rejection further set forth an improper 102 rejection when combined with a reference and well known prior art is defective grounds for rejection and such should have been rejected under 103 with regards to claim 14.

Decision:
A careful review of the entire application record indicates that the petitioner's request to withdraw the finality of the Office action mailed October 10, 2006 has merit.
Specifically, MPEP 706.07 states:

> "Before final rejection is in order a clear issue should be developed between the examiner and the applicant."

In the instant application the first Office action of March 23, 2006; claims 11-19 were rejected under 35 USC 102(e) as being anticipated by Cheng(US 2003/008246), claims 20-24 were rejected as being anticipated under 35 USC 10(b) as being anticipated by Japan 63-244622, claims 25-29 were rejected under 35 USC 102(e) as being anticipated by Nishi(US2003/0032302), and claims 30-33 were rejected under 35 USC102(b) as being anticipated by Templeton(US 2002/0046703). The FINAL action mailed October 10, 2006 rejected the same claims under the same statutes with the same references.

MPEP 707(d) states that

"A plurality of claims should never be grouped together in a common rejection unless that rejection is equally applicable to all claims in the group."

In this case the Office actions failed to address the specific features of all the dependent claims and improperly made an obvious rejection of claim 14 over well known common knowledge of the art in the FINAL action.

Since the Office actions did not address the patentability of each claim independently and the Examiner has improperly grouped a plurality of claims in a common rejection which is not equally applicable to all the claims in the group, the finality of the Office action of October 10, 2006 was inappropriate. Thus no clear issue has been developed between applicant and the examiner. Therefore, the finality of the Office Action is hereby withdrawn. As a consequence, the applicants' AMENDMENT of November 07, 2006 should now be entered. The application shall be returned for consideration of the November 07, 2006 AMENDMENT. An office action shall follow in due course.

The petition is **GRANTED.**

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